



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/691,801

10/22/2003

Jawed Asrar

17396/09169

6674

27530

7590

06/14/2007

NELSON MULLINS RILEY & SCARBOROUGH, LLP  
1320 MAIN STREET, 17TH FLOOR  
COLUMBIA, SC 29201

EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

06/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/691,801

Applicant(s)

ASRAR ET AL.

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-47 and 57-92 is/are pending in the application.
- 4a) Of the above claim(s) 58,-67,69-74,76-85,87-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-47,57,68,75,86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/14/06; 9/22/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42-47, 57, 68, 75, 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofer et al (USPN 6875727; 4/5/05). Hofer teaches a method of controlling pest comprising applying to a plant seed a composition comprising abamectin (avermectin- biological / fermentation product). See abstract, claim 1. Hofer teaches that other actives including MTI-446 (dinotefuran) and spinosad (biological / fermentation product) can be added to the composition. See claim 7, column 112, line 30 –column 113 line 30. Hofer teaches that the composition is applied to the as a seed dressing meaning that the composition is being applied to unsown seed. See column 113 line 41 – column 36, Hofer teaches that the composition is applied to transgenic and non-transgenic crop seeds such as corn seed. Hofer does not exemplify a method of controlling pest comprising applying the composition comprising abamectin, MTI-446, and / or spinosad to plant seed. However, looking at claims 1 and 7 it is noted that Hofer strongly suggests an invention comprising abamectin and MTI-446 (dinotefuran). It would have been obvious at the time of Hofer's invention to make an invention comprising abamectin and MTI-446 (dinotefuran). One would have been motivated to make this combination because it is strongly suggested by Hofer. See claims 1 and 7. It

would have also been obvious to one having skill in the art at the time of Hofer invention to make an invention comprising abamectin, spinosad, and MTI-446. Note at column line of Hofer it is suggested that a variety actives can be added to the composition. See column 112 lines 56-64.

Claims 42-47, 57, 68, 75, 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (USAN 2003050326; 3/13/03). Lee teaches a method of controlling pest comprising applying to a plant seed a composition comprising nitroguanidine compounds. See paragraph 1. Lee teaches that other actives including abamectin (avermectin- biological / fermentation product) and spinosad (biological / fermentation product) can be added to the composition. See paragraphs 62-66. Lee teaches that the composition can be used as a seed dressing meaning that the composition is being applied to unsown seed. See paragraph 67. Lee teaches that the composition is applied to transgenic and non-transgenic crop seeds such as corn seed. See paragraph 5. Lee does not exemplify a method of controlling pest comprising applying the composition comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. Lee does not specifically teach MTI 446 as the nitroguanidine compound. However the broad teaching of nitroguanidine compound in Lee covers MTI a species. One having ordinary skill in the art would have been expected to use the MTI 446 at the time Lee's invention was made. One would have motivate to do this since compound in a genus have similar chemical and physical properties and therefore should show similar activity when used. However, in the reviewing of paragraphs 1, 62-67 it is noted that Lee strongly suggests an invention comprising nitroguanidine plus

abamectin and / or spinosad as a seed dressing. It would have been obvious at the time of Lee's invention to make an invention comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. One would have been motivated to make this combination because it is strongly suggested by Lee.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 42-47,57,68 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 27 of U.S. Patent No. 6586365 in view of Lee et al (USAN 2003050326; 3/13/03). USPN '365 claims a method of protecting transgenic corn plants from pests comprising applying to the transgenic corn plant seed a composition comprising the nitroguanidine compound chlothianidin. Note instant claims are to a method of controlling pests on plants including transgenic

corn plants comprising applying to the seed of the transgenic plant a nitroguanidine compound (specifically MTI 446). Note USPN '365 does not claim a method comprising biological / fermentation products such as avermectin and spinosad and the nitroguanidine compound MTI 446. It would have been obvious to use clothianidin and MTI-446 interchangeably, because of the similarity between the nitroguanidine compounds. With respect to USPN '365, Lee makes it obvious to add avermectin and / or spinosad to nitroguanidine compounds. Lee teaches a method of controlling pest comprising applying to a plant seed a composition comprising nitroguanidine compounds. See paragraph 1. Lee teaches that other actives including abamectin (avermectin- biological / fermentation product) and spinosad (biological / fermentation product) can be added to the composition. See paragraphs 62-66. Lee teaches that the composition can be used as a seed dressing meaning that the composition is being applied to unsown seed. See paragraph 67. Lee teaches that the composition is applied to transgenic and non-transgenic crop seeds such as corn seed. See paragraph 5. Lee does not exemplify a method of controlling pest comprising applying the composition comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. However, in the reviewing of paragraphs 1,62-67 it is noted that Lee strongly suggests an invention comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. It would have been obvious at the time of Lee's invention to make an invention comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. One would have been motivated to make this combination because it is strongly suggested by Lee. It would have been obvious to modify the invention of USPN '365 with Lee. One

would have been motivated to do this since Lee discloses the combination of spinosad and / or MTI-466 plus a nitroguanidine compound.

Claims 42-47, 57, 68, 75, 86 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 9, 10, 19, 26, 28-36, 39-41, 48, 49 of U.S. Patent No. 6660690 in view of Lee et al (USAN 2003050326; 3/13/03). USPN '690 claims a method of protecting transgenic corn plants from pests comprising applying to the transgenic corn plant seed a composition comprising nitroguanidine compound, biological / fermentation and a pyrethrin compound. Note instant claims are to a method of controlling pests on plants including transgenic corn plants comprising applying to the seed of the transgenic plant a nitroguanidine compound (specifically MTI 446). Note USPN '690 does not claim a method specifically comprising biological / fermentation products such as avermectin and spinosad and the nitroguanidine compound MTI 446. It would have been obvious to make an invention specifically comprising biological / fermentation products such as avermectin and spinosad and the nitroguanidine compound MTI 446. With respect to USPN '690, Lee makes it obvious to add avermectin and / or spinosad to nitroguanidine compounds. Lee teaches a method of controlling pest comprising applying to a plant seed a composition comprising nitroguanidine compounds. See paragraph 1. Lee teaches that other actives including abamectin (avermectin- biological / fermentation product) and spinosad (biological / fermentation product) can be added to the composition. See paragraphs 62-66. Lee teaches that the composition can be used as a seed dressing meaning that the composition is being applied to unsown seed. See paragraph 67. Lee teaches that the

composition is applied to transgenic and non-transgenic crop seeds such as corn seed. See paragraph 5. Lee does not exemplify a method of controlling pest comprising applying the composition comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. However, in the reviewing of paragraphs 1,62-67 it is noted that Lee strongly suggests an invention comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. It would have been obvious at the time of Lee's invention to make an invention comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. One would have been motivated to make this combination because it is strongly suggested by Lee. It would have been obvious to modify the invention of USPN '690 with Lee. One would have been motivated to do this since Lee discloses the combination of spinosad and / or MTI-466 plus a nitroguanidine compound.

Claims 42-47,57,68,75,86 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,24 and 28 of copending Application No. 09/968174 in view of Lee et al (USAN 2003050326; 3/13/03). USAN '174 claims a method of protecting transgenic corn plants from pests comprising applying to the transgenic corn plant seed a composition comprising the nitroguanidine compound thiamethoxam. Note instant claims are to a method of controlling pests on plants including transgenic corn plants comprising applying to the seed of the transgenic plant a nitroguanidine compound (specifically MTI 446). Note USAN '174 does not claim a method comprising biological / fermentation products such as avermectin and spinosad and the nitroguanidine compound MTI 446. It would have been obvious to use chlothianidin and MTI-446 interchangeably, because of the similarity between the



Art Unit: 1616

nitroguanidine compounds. With respect to USPN '174, Lee makes it obvious to add avermectin and / or spinosad to nitroguanidine compounds. Lee teaches a method of controlling pest comprising applying to a plant seed a composition comprising nitroguanidine compounds. See paragraph 1. Lee teaches that other actives including abamectin (avermectin- biological / fermentation product) and spinosad (biological / fermentation product) can be added to the composition. See paragraphs 62-66. Lee teaches that the composition can be used as a seed dressing meaning that the composition is being applied to unsown seed. See paragraph 67. Lee teaches that the composition is applied to transgenic and non-transgenic crop seeds such as corn seed. See paragraph 5. Lee does not exemplify a method of controlling pest comprising applying the composition comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. However, in the reviewing of paragraphs 1,62-67 it is noted that Lee strongly suggests an invention comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. It would have been obvious at the time of Lee's invention to make an invention comprising nitroguanidine plus abamectin and / or spinosad as a seed dressing. One would have been motivated to make this combination because it is strongly suggested by Lee. It would have been obvious to modify the invention of USPN '174 with Lee. One would have been motivated to do this since Lee discloses the combination of spinosad and / or MTI-466 plus a nitroguanidine compound.

This is a provisional obviousness-type double patenting rejection.

***Application Information***

Examiner acknowledges Applicants' election of species comprising denotefuran and a biological / fermentation product. The election is not allowable. The restriction is final.

The 112, 1<sup>st</sup> paragraph rejection is withdrawn in light of amend file 3/23/07

Examiner acknowledges Applicant willingness to file a Terminal Disclaimer to overcome rejection with respect to USPN 6593273. The double patenting rejection is maintained.


***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Alton Pryor  
Primary Examiner  
AU 1616